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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,155	04/01/2004	Barry W. Townsend	183.39735AP7	7370

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/814,155	Applicant(s) TOWNSEND ET AL.	
	Examiner Javier G. Blanco	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3, 12 and 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 13-18, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 23
Paper No(s)/Mail Date <u>8/12/04; 4/11/05; 10/12/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Prosthetic Foot: Species H (embodied in Figures 46 and 47), Calf Shank: Species A (embodied in Figure 15), Foot Keel: Species B (embodied in Figures 6 and 7), and Coupling Element: Species A (embodied in Figure 23) in the reply filed on December 5, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3, 12, and 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 5, 2005.

Priority

3. The instant Application is a continuation-in-part of Application No 10/473,682 (comprising Figures 1-40), which is the U.S. national designated filing under 35 U.S.C. 371 of international application PCT/US02/09589, which is a continuation-in-part of US 6,562,075 (comprising Figures 1-27). The instant Application is also a continuation-in-part of Application No 10/263,795 (comprising Figures 1-27), which is a continuation-in-part of Application No 09/820,895 (now US 6,562,075).
4. Independent claims 1 and 10 of the instant application (comprising Figures 1-54) claim a prosthetic foot comprising a shank (or ankle) monolithically formed with a foot keel. The term "monolithic" is generally defined as "cast/formed as a single piece". Figures 46 and 48 of the

instant application show/describe a shank (or ankle) monolithically formed with a foot keel.

Figures 46 and 48 were introduced for the first time in the present/instant application. None of the above-mentioned applications disclose a shank (or ankle) monolithically formed with a foot keel. Independent claims 1 and 10 are directed to subject matter that was introduced for the first time in the present application, filed April 1, 2004. Thus, the effective filing date for the subject matter of independent claims 1 and 10 is April 1, 2004.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2, 4-11, 13-18, 23, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 6,562,075. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because the difference between claims 1, 2, 4-11, 13-18, 23, and 24 of the application and claims 1-51 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific (except for disclosing a shank (or ankle) monolithically formed with a foot keel). Thus the invention of claims 1-51 of the patent is in effect a “species” of the “generic” invention of claims 1, 2, 4-11, 13-18, 23, and 24. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1, 2, 4-11, 13-18, 23, and 24 of the application are anticipated by claims 1-51 of the patent, it is not patentably distinct from claims 1-51.

7. Claims 1, 2, 4-11, 13-18, 23, and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (i) Claims 62, 63, 66, 70, 71, 72, 89, 91, and 94-96 of copending Application No. 10/263,795;
- (ii) Claims 55, 57, 62, and 63-66 of copending Application No. 10/408,107;
- (iii) Claims 1-26 of copending Application No. 10/473,680; and
- (iv) Claims 21-24 of copending Application No. 10/814,260.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a prosthetic foot comprising an anterior facing convexly curved shank connected to a foot keel. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1, 2, 4-9, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 1, the limitation “the lower portion of the shank” (see line 7) lacks antecedent basis. Claims 2, 4-9, and 23 depend on claim 1.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4-11, 13-18, 23, and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Atkinson et al. (US PG Pub No 2002/0087216 A1; cited in Applicants’ IDS).

Referring to Figures 8, 9, 11, 13, 14, 19, and 29, Atkinson et al. disclose a prosthetic foot comprising a longitudinally extending foot keel; a resilient, monolithically formed shank extending upwardly from the foot keel to form an ankle joint area of the prosthetic foot and a lower, prosthetic part of a leg above the ankle joint area for connection with a lower extremity prosthetic socket on a person’s leg stump; wherein at least a portion of the shank extending upwardly from the foot keel is anterior facing convexly curved; and wherein the shank and at least a portion of the foot keel are monolithically formed (i.e., “cast or formed from a single piece, element, or structure”, as disclosed in paragraph 0082). The shank and foot keel are formed of metal or plastic (see paragraphs 0044 and 0047).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

February 17, 2006



David H. Willse
Primary Examiner